

**THIS DISPOSITION  
IS NOT A PRECEDENT  
OF THE TTAB**

Mailed: July 30, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

\_\_\_\_\_  
Trademark Trial and Appeal Board

\_\_\_\_\_  
In re Excel Program Inventions

\_\_\_\_\_  
Serial No. 78784785

\_\_\_\_\_  
Excel Program Inventions, *pro se*.

Sally Shih, Trademark Examining Attorney, Law Office 106  
(Mary I. Sparrow, Managing Attorney).

\_\_\_\_\_  
Before Walters, Taylor and Mermelstein, Administrative  
Trademark Judges.

Opinion by Taylor, Administrative Trademark Judge:

Excel Program Inventions, a sole proprietorship with John Caine listed as the sole proprietor, has filed an application to register the mark DATABASE ASSISTANT, in standard character format, on the Principal Register for goods identified as "Computer software for use in database management and application maintenance" in Class 9.<sup>1</sup>

\_\_\_\_\_  
<sup>1</sup> Serial No. 78784785, filed January 4, 2006, and alleging October 1, 2005 as the date of first use of the mark anywhere and in commerce.

The trademark examining attorney has refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1) on the ground that applicant's mark DATABASE ASSISTANT is merely descriptive of the function of the identified goods.

When the refusal was made final, applicant filed a request for reconsideration that was found unpersuasive. Applicant subsequently filed an appeal. Both applicant and the examining attorney have filed briefs. We affirm the refusal to register.

Before discussing the merits of this case, we must address a preliminary matter. The examining attorney objects to entry into the record of third-party registrations attached to applicant's appeal brief. The objection is based on the examining attorney's contention that these registrations were introduced for the first time as attachments to applicant's appeal brief. While the examining attorney is correct that the record in any application must be complete prior to the appeal,<sup>2</sup> the third-party registrations previously were submitted with applicant's responses to the examining attorney's first and final office actions. Consequently, they are already of

---

<sup>2</sup> See Trademark Rule 2.142(d); 37 C.F.R. § 2.142(d).

record as part of the application file. Accordingly, the examining attorney's objection is overruled.<sup>3</sup>

Considering now the merits of this case, the test for determining whether a mark is merely descriptive is whether the involved term immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or services in connection with which it is used, or intended to be used. See, e.g., *in re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987), and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the goods or services in order to be considered merely descriptive; it is enough that the term describes one significant attribute, feature or property of the goods or services. *In re MBAssociates*, 180 USPQ 338 (TTAB 1973).

Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used or intended to be used, and the possible

---

<sup>3</sup> We add that applicant's resubmission of the third-party registrations, as well as other previously submitted evidence, with its brief was unnecessary. See *ITC Entertainment Group Ltd. v. Nintendo of America Inc.*, 45 USPQ2d 2021, 2022-23 (TTAB 1998) (submission of duplicative papers is a waste of time and resources, and is a burden upon the Board).

significance that the term would have to the average purchaser of the goods or services because of the manner of its use. In re Recovery, Inc., 196 USPQ 830 (TTAB 1977).

The examining attorney maintains that the proposed mark DATABASE ASSISTANT is merely descriptive of applicant's software for use in database management and application maintenance. The examining attorney particularly argues:

The term DATABASE is merely descriptive of the field of use as described by the applicant in the identification of goods. The term ASSISTANT is merely descriptive of a function or use of the software, namely, assisting in managing the database.

\*\*\*

The proposed mark, although it is made up of two words, is a composition of words that has only one meaning, in this case, a merely descriptive meaning in relation to the identified goods.

(Brief, pp. 2 and 7).

In support of the refusal, the examining attorney submitted the following definitions of "database" and "assistant."<sup>4</sup> Database is defined, in relevant part, as:

1. a large collection of information arranged for quick retrieval, updating, or

---

<sup>4</sup> The definitions are taken from the online version of Wordsmyth found at [www.wordsmyth.net/live/home](http://www.wordsmyth.net/live/home).

the like, esp. such a collection in a computer.

Assistant is defined, in relevant part, as:

1 a person who gives help, aid, or assistance.

Additionally, we take judicial notice of the following definition of "assistant":

NOUN: 2. Giving aid; auxiliary.<sup>5</sup>

The examining attorney also submitted results from a search of Google search engine for the term "database assistant" and excerpts from the websites [www.markosoft.net](http://www.markosoft.net); [www.bluechillies.com](http://www.bluechillies.com); and [www.hotlib.com](http://www.hotlib.com) to show that the term is used in connection with computer software such as that of applicant.

Applicant contends that the examining attorney has failed to provide any factual evidence to meet the burden necessary to justify the refusal. Insofar as the Internet evidence obtained is concerned, applicant argues that in each instance the mark "DATABASE ASSISTANT" unambiguously appears, it is the "complete NAME of the product and NOT the description thereof,"<sup>6</sup> and that the evidence is mainly

---

<sup>5</sup> The American Heritage Dictionary of the English Language (4<sup>th</sup> ed. 2000).

<sup>6</sup> (Brief, unnumbered p. 2).

comprised of multiple references to one product named "Database Assistant" from a company called Markosoft. As regards the dictionary definitions of the words "database" and "assistant," applicant, citing *Concurrent Technologies Inc. v. Concurrent Technologies Corp.*, 12 USPQ2d 1054, 1057 (TTAB 1989), argues that such evidence "is not proof of 'descriptiveness' in itself: ... Common words may be descriptive when standing alone, but when together in a composite mark, they may become a valid trademark." (*Id.*)

With regard to the examining attorney's Internet evidence, as applicant pointed out, the pertinent Internet references refer to a single product apparently sold by Markosoft Industries. The webpage from [www.markosoft.net](http://www.markosoft.net), for example, states that "[t]he Markosoft Database Assistant is an all-in one database access tool for use in viewing and editing ... Additionally, the Database Assistant provides a way to pre-configure all of the data sources that you commonly use..." (Office Action issued July 26, 2006, Attachment 3). This language, similar to that used in the other two web pages of record, fails to show the term "database assistant" unequivocally used descriptively or as a trademark. Therefore, the probative value of this evidence is limited, at best, in assessing the consuming public's perception of the term DATABASE

ASSISTANT as describing applicant's computer software for use in database management and application maintenance.

Nonetheless, the record sufficiently demonstrates that the designation DATABASE ASSISTANT immediately conveys the function and/or purpose of applicant's goods. The dictionary definition submitted by the examining attorney as well as applicant's own use of the term "database" in the identification of goods show that DATABASE directly describes an attribute of applicant's goods. Additionally, as previously indicated, the term "assistant" means "[g]iving aid." Because applicant's computer software "aids" the user in database management and application maintenance, the word "assistant" is merely descriptive of applicant's goods.

In view of the above, we find that the individual terms DATABASE and ASSISTANT have descriptive significance as used in connection with the identified goods.

When two or more merely descriptive terms are combined, we must determine whether the combination of terms evokes a new and unique commercial impression. If each component retains its merely descriptive significance in relation to the goods, then the resulting combination is also merely descriptive. See, e.g., *In re Tower Tech*,

**Ser No.** 78784785

Inc., 64 USPQ2d 1314 (TTAB 2002) (SMARTTOWER held merely descriptive of commercial and industrial cooling towers).

We find that the record establishes that the designation DATABASE ASSISTANT, as a whole, is descriptive of the identified goods. When the mark DATABASE ASSISTANT is viewed on or in connection with the goods listed in the application, there is nothing in the mark which is incongruous, nor is there anything which would require the gathering of further information, in order for the merely descriptive significance thereof to be readily apparent to prospective purchasers of the goods. See, for example, In re Abcor Development Corp., Inc., 588 F.2d 811, 200 USPQ 215 (CCPA) (Rich, J., concurring) [GASBADGE described as a shortening of the name "gas monitoring badge"]; and Cummins Engine Co., Inc. v. Continental Motors Corp., 359 F.2d 892, 149 USPQ 559 (CCPA 1966) [TUBODIESEL held generically descriptive of engines having exhaust driven turbine superchargers]. That is, the combination of the words "database" and "assistant" fail to create a new and distinct commercial impression.

As evidenced by applicant's specimens of record, which include what appears to be an informational flyer, the purchasing public would perceive the designation DATABASE ASSISTANT as descriptive of applicant's computer software

used for database management and application maintenance.

The flyer reads, in relevant part, as follows:

Introducing a programming productivity aid  
which dramatically reduces the time and  
effort required to make changes to database  
files and RPG applications on the iSeries  
and AS/400...

\*\*\*

Database Assistant<sup>TM</sup>

A Programmer Productivity Aid and Field Level  
Database Relations Tool

When prospective consumers encounter the designation DATABASE ASSISTANT in this context, it is clear that it would immediately inform these consumers that applicant's software aids the user in database management and application maintenance.

Lastly, applicant states that "[f]or probative value please refer to Exhibit B and the associated attachments therein (A to J) which show how similar marks have routinely been granted registration by the PTO." (Brief at unnumbered p. 2).<sup>7</sup> We note, however, in determining the issue of descriptiveness, prior registrations are of little value because each case must be determined on its own facts. In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d

---

<sup>7</sup> Exhibit B includes copies of previously submitted third-party registrations for marks that include the term "assistant" with other matter for a variety of goods and services.

**Ser No.** 78784785

1564 (Fed. Cir. 2001) (“Even if some prior registrations had some characteristics similar to Nett Designs’ application [LOAD LLAMA THE ULTIMATE BIKE RACK], the PTO’s allowance of such prior registrations does not bind the Board or this court”); and *In re Scholastic Testing Service, Inc.*, 196 USPQ 517 (TTAB 1977). We are constrained to decide this appeal on the record before us.

We conclude that when applied to applicant’s goods, the designation DATABASE ASSISTANT immediately describes, without any kind of mental reasoning, the function of the goods listed in the application, i.e., “computer software for use in database management and application maintenance.”

**Decision:** The refusal to register under Section 2(e)(1) of the Trademark Act is affirmed.

**Ser No.** 78784785